

**REMARKS**

**STATUS OF CLAIMS**

In response to the Office Action dated January 8, 2009 claims 1-4 have been amended. Claims 1-4 are now pending in this application.

**REJECTION OF CLAIMS UNDER 35 U.S.C. § 112, SECOND PARAGRAPH**

Claims 1-4 have been rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. The Examiner contends that the scope of the claims is indefinite.

By this response, claims 1-4 have been amended to more clearly delineate the subject matter of the invention. Thus, amended claim 1 is directed to a transmission origin apparatus which allows a file to be transmitted to a transmission destination apparatus, where the transmission origin apparatus and the transmission destination apparatus are connected in an information transmission system and operate based on different protocols. A problem with protocol is described at, for example, pages 1-2 of the present application.

Amended claim 2 is directed to a transmission destination apparatus connected with a transmission origin apparatus in an information transmission system and which allows a file to be transmitted from the transmission origin apparatus to the transmission destination apparatus, which operate based on different protocols.

Amended claim 3 is directed to an information transmission system comprising, *inter alia*, a transmission origin apparatus and a transmission destination apparatus connected together using a standardized serial interface standard, and which operate based on different protocols.

Amended claim 4 is directed to a method for copying a file from a transmission origin apparatus to a transmission destination apparatus, where the transmission origin apparatus and the transmission destination apparatus are connected in an information transmission system and operate based on different protocols.

It is submitted that case law precedent has established that an analysis under 35 U.S.C. § 112 begins with a determination of whether the claims do, in fact, set out and circumscribe a particular area with a reasonable degree of precision and particularity. Claim language is viewed not in a vacuum, but in light of the teachings of the prior art and of the application disclosure as it would be interpreted by one possessing the ordinary level of skill in the art. *In re Johnson*, 558 F.2d 1008, 194 USPQ 187 (CCPA 1977); *In re Moore*, 439 F.2d 1232, 169 USPQ 236 (CCPA 1971).

A decision on whether a claim is invalid under this section of the statute requires a determination of whether those skilled in the art would understand what is claimed when the claim is read in light of the specification, *Seattle Box Co. v Industrial Crating & Packing*, 731 F.2d 381, 385, 221 U.S.P.Q. 568, 574 (Fed. Cir. 1984).

In determining definiteness, no claim may be read apart from and independent from the disclosure on which it is based. *In re Cohn*, 169 U.S.P.Q. 95, 98 (CCPA 1971); *In re Kroekel*, 183 U.S.P.Q. 610, 612 (CCPA 1974):

... claims are not to be considered in a vacuum, "but always in light of the teachings of the prior art and the particular application disclosure as it would be viewed by one possessing the ordinary level of skill in the pertinent art." When considered in light of the prior art and the specification, claims otherwise indefinite may be found reasonably definite.

It is submitted that when the language of claims 1-4, as amended, is read in light of the specification, an artisan would readily understand the metes and bounds of the claimed invention.

It should be noted also that the language in a claim does not have to be identical to language in the specification. *In re Lukach*, 442 F.2d 967, 969, 169 USPQ 795 (CCPA 1971); *In re Wertheim*, 541 F.2d 257, 262, 191 USPQ 90, 97 (CCPA 1976), appeal after remand 646 F.2d 527, 209 USPQ 554 (CCPA 1981); *Kennecott Corp. v. Kyocera International, Inc.* 835 F.2d 1419, 1422, 5 USPQ2d 1194, 1197 (Fed. Cir. 1987), cert. denied, 486 U.S. 1008 (1988); *Vas-Cath Inc. v. Mahurkar*, 935 F.2d 1555, 19 USPQ2d 1111 (Fed. Cir. 1991).

In view of the above, withdrawal of the rejection under 35 U.S.C. § 112, second paragraph, as to amended claims 1-4 is respectfully solicited.

#### **REJECTION OF CLAIMS UNDER 35 U.S.C. § 101**

Claims 1-4 have been rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter.

Each of claims 1-3, as amended, recites sufficient structure to constitute a machine or manufacture within the means of 35 U.S.C. § 101. For example, amended claims 1-3 recite a *transmission origin storage device*. Such storage device is, for example, memory card device 40 of Fig. 2 which is part of still camera 11. In addition, amended method claim 4 delineates, *inter alia*, a step of detecting a folder structure in a *transmission origin storage device* of the transmission origin apparatus.

Thus, each of amended claims 1-3 has at least one claimed element that is a physical element of the claimed apparatus and system. In addition, amended method claim 4 has at least

the step of detecting a folder structure carried out with respect to a physical element; i.e., a *transmission origin storage device* of the transmission origin apparatus.

The following comments are provided in response to the Examiner's comments with regard to there being no explicit definition of (i) transmission origin storage means of the transmission origin apparatus, (ii) monitoring means, (iii) savings means, (iv) transmission destination storage means and (v) file folder structure.

(i) The transmission origin storage means is now a transmission origin storage device and can be, for example, memory card device 40 of Fig. 2 which is part of still camera 11.

(ii) The monitoring means refers to the monitoring resident software 61 depicted in Fig. 2 and described, for example, at page 8, lines 7-10 of the present application.

(iii) Savings means is now "copying means" and can be, for example, the copy application software 62 in CPU 30 and which is described at, for example, page 13, lines 14-21 of the present application. In addition, in the claims, "saved" has been replaced with "stored".

(iv) The transmission destination storage means is now a transmission destination storage device and can be, for example, the HDD 34 of the PC 30 of Fig. 2 of the present application.

(v) The file folder structure refers to the file storage folder structure 41 and 341 of Fig. 2 (see page 7, line 28 to page 8, line 2 and page 8, lines 22-25 of the present application).

In view of the above, withdrawal of the rejections under 35 U.S.C. § 101, as to amended claims 1-4 being directed to non-statutory subject matter is respectfully solicited.

**REJECTION OF CLAIMS UNDER 35 U.S.C. § 102**

Claims 1-4 have been rejected under 35 U.S.C. § 102(e) as being anticipated by Tanaka et al. (US Publication 2001/0048534).

Amended claim 1 delineates, *inter alia*:

...  
identification of the transmission origin *apparatus* of the file to be transmitted is made on the basis of a file storage folder structure that has been pre-standardized for both the transmission origin apparatus and a transmission destination apparatus of the information transmission system in order to identify the identifying file contained in the file storage folder structure as an identifying file for a transmission origin *apparatus of the information transmission system*, and

the identifying file in the transmission origin apparatus is identified as an identifying file *for* a transmission origin *apparatus of the information transmission system* when the file structure of the identifying file has the same file format and data contents as the file format and data contents that have been pre-standardized for an identifying file *for* a transmission origin *apparatus* of the information transmission system, and by which any apparatus of the information transmission system that has the pre-standardized file storage folder structure can be identified as *a transmission origin apparatus* of a file that can be transmitted to *any transmission destination* apparatus of the information transmission system that has the pre-standardized file storage folder structure, even when both *the transmission origin apparatus and the transmission destination apparatus operate* based on different *protocols*.

Thus, amended claim 1 requires, *inter alia*, that identification of the transmission origin apparatus of the file to be transmitted is made on the basis of a file storage folder structure that has been pre-standardized for both the transmission origin apparatus and a transmission destination apparatus of the information transmission system. In addition, even when both the transmission origin apparatus and the transmission destination apparatus operate based on different protocols, the identifying file in the transmission origin apparatus is identified as an identifying file for a transmission origin apparatus of the information transmission system when

the file structure of the identifying file has the same file format and data contents as the file format and data contents that have been pre-standardized for an identifying file for a transmission origin apparatus of the information transmission system. Tanaka et al. does not disclose or suggest such features, as now recited in amended claim 1.

Furthermore, even if the print file depicted in Fig. 7 of Tanaka et al. contains a unique structure which contains information that identifies the image files, there is nothing in Tanaka et al. that discloses or suggests that such print file is identified as an identifying file for a transmission origin apparatus of an information transmission system when the file structure of the identifying file has the same file format and data contents as the file format and data contents that have been pre-standardized for an identifying file for a transmission origin apparatus of the information transmission system. More specifically, Tanaka et al. has no disclosure or suggestion regarding the print file being an identifying file for a transmission origin apparatus of an information transmission system or the file format and data contents of such identifying file being the same file format and data contents that have been pre-standardized for an identifying file for a transmission origin apparatus of the information transmission system.

Similar subject matter as that noted above with respect to amended claim 1 is recited amended claims 2-4.

As noted in the previous Response, Tanaka et al. is concerned with image data communication, as is the present application. However, Tanaka et al. is not concerned with the problem of transferring files from a transmission origin apparatus to a transmission destination apparatus, which operate based on different protocols, as is the case for the invention recited in

claims 1-4, as amended. Therefore, claims 1-4, as amended, are patentable over Tanaka et al. and their allowance is respectfully solicited.


**CONCLUSION**

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

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Respectfully submitted,

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